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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,486	02/10/2004	Seiichi Katano	49987-1003	3258

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EXAMINER
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TESLOVICH, TAMARA

ART UNIT	PAPER NUMBER
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2137

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05/13/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/776,486	<b>Applicant(s)</b> KATANO, SEIICHI	
	<b>Examiner</b> Tamara Teslovich	<b>Art Unit</b> 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01.17.08</u>  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Office Action is in response to Applicant's Remarks and Amendments filed February 14, 2008.

Claim 5 is amended.

Claims 8-26 remain cancelled.

Claims 1-7 are pending and herein considered.

### ***Response to Arguments***

Applicant's arguments, see pages 5-17, have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112, 1<sup>st</sup> Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 1 includes limitations regarding *"a scan process executing in the memory and being configured to cause a printed document to be scanned at the multi-functional peripheral device and to generate scan*

*data that includes a digital representation of the electronic document” and “a print process executing in the memory and bring configured to process print data and cause a printed version of an electronic document reflected in the print data to be generated by the multi-function peripheral device at the multi-function peripheral device.”* The Examiner has conducted a thorough examination of Applicant’s specification and is unable to locate any areas within Applicant’s original disclosure that might provide for Applicant’s detailed “print process” and “scan process.” The only mentions of “scanning” and “printing” appear to refer to the scanning and printing capabilities of a multi function peripheral and as such fail to provide the specificity as claimed in Applicant’s newly amended claims. The Examiner invites Applicant to point out those specific sections within the specification that provide for the abovementioned claim limitations so that she might reconsider her rejections. Insofar as the remaining pending claims are based upon rejected independent claim 1, the Examiner rejects all pending claims for those reasons given above with respect to claim 1.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the electronic document" in line 10. There is insufficient antecedent basis for this limitation in the claim. Furthermore, the presence of "an electronic document" in line 12 further confuses the issue insofar as it is unclear whether the "electronic document" in line 10 is separate and distinct from the "electronic document" of line 12, or whether they are in fact the same document. Claims 2-7 depend upon rejected independent claim 1, and are rejected accordingly.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent Application Publication No. 2004/0193895 A1 to Kotaro *Kaneko* and further in view of United States Patent Application Publication No. 2001/0005889 A1 to Mikael *Albrecht*.

As per **claim 1**, *Kaneko* teaches a multi-function peripheral device comprising: a network interface configured to allow the multi-function peripheral device to communicate with network devices over a network (pars 16, 26-28); a graphical user interface configured to allow for the exchange of information between the multi-function peripheral device and a user (pars 22-29); one or more processors (pars 14-15); a

memory (pars 28, 94); a scan process executing in the memory and being configured to cause a printed document to be scanned at the multi-function peripheral device and to generate scan data that includes a digital data representation of the electronic document (par 27); a print process executing in the memory and being configured to process print data and cause a printed version of an electronic document reflected in the print data to be generated by the multi-function peripheral device at the multi-function peripheral device (pars 27, 39, 64, 71).

*Kaneko* fails to specifically teach a virus protection process executing in the memory and being configured to perform the steps of detecting that a request for data to be analyzed for viral infection has been received by the multi-function peripheral device over the network from a network device and in response to detecting receipt of the request, causing the data to be provided from the multi-function peripheral device to the network device over the network to enable the data to be analyzed for viral infection at the network device.

*Albrecht* teaches a virus protection process executing in the memory and being configured to perform the steps of detecting that a request for data to be analyzed for viral infection has been received by the multi-function peripheral device over the network from a network device (pars 28-29 “dialogue initiation request from 2<sup>nd</sup> computer”); and in response to detecting receipt of the request, causing the data to be provided from the multi-function peripheral device to the network device over the network to enable the data to be analyzed for viral infection at the network device (par 31).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include within *Kaneko* the virus protection process allowing for the detection of requests from a network device for data to be analyzed and the sending of that data to be analyzed as described in *Albrecht* to provide an MFP with increased security capabilities without requiring the need for excess processing power and memory.

As per **claim 2**, the combination of *Kaneko* and *Albrecht* teaches the multi-function peripheral device as recited in Claim 1, wherein providing data from the multi-function peripheral device to the network device over the network includes: providing one or more data files to the network device over the network (*Albrecht* pars 13 “electronic files which require virus scanning”, 47; *Kaneko* pars 36-38, 40-42, 72-73).

As per **claim 3**, the combination of *Kaneko* and *Albrecht* teaches the multi-function peripheral device as recited in Claim 1, wherein providing data from the multi-function peripheral device to the network device over the network includes: providing configuration data to the network device over the network (*Albrecht* pars 13 “electronic files which require virus scanning”, 47; *Kaneko* pars 36-38, 40-42, 72-73).

As per **claim 4**, the combination of *Kaneko* and *Albrecht* teaches the multi-function peripheral device as recited in Claim 1, wherein the memory stores additional instructions which, when processed by the one or more processors, cause the multi-

function peripheral device to perform the steps of: receive replacement data from the network device that has been disinfected; and replace the data on the multi-function peripheral device with the replacement data (*Albrecht* par.18; *Kaneko* pars 85-87).

As per **claim 5**, the combination of *Kaneko* and *Albrecht* teaches the multi-function peripheral device as recited in Claim 4, wherein the memory stores other instructions which, when processed by the one or more processors, cause the multi-function peripheral device to: after replacing the data on the multi-function peripheral device with the replacement data, generate and send a confirmation message to the network device (*Albrecht* par.46; *Kaneko* pars 88-89).

As per **claim 6**, the combination of *Kaneko* and *Albrecht* teaches the multi-function peripheral device as recited in Claim 4, wherein the memory stores other instructions which, when processed by the one or more processors, cause the multi-function peripheral device to: after replacing the data on the multi-function peripheral device with the replacement data, generate a report and either print the report at the multi-function peripheral device or fax the report to another location (*Kaneko* pars 88-89).

As per **claim 7**, the combination of *Kaneko* and *Albrecht* teaches the multi-function peripheral device as recited in Claim 1, wherein the memory stores additional instructions which, when processed by the one or more processors, cause the multi-



function peripheral device to perform the steps of: receive a request from the network device for the multi-function peripheral device to quarantine or delete at least a portion of the data that was sent from the multi-function peripheral device to the network device; and in response to receiving the request from the network device to quarantine or delete at least a portion of the data that was sent to the network device, quarantine or delete the at least a portion of the data that was sent from the multi-function peripheral device to the network device (*Albrecht* par 18; *Kaneko* pars 85-87, 95).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara Teslovich whose telephone number is (571) 272-4241. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2137

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tamara Teslovich/  
Examiner, Art Unit 2137

/Emmanuel L. Moise/  
Supervisory Patent Examiner, Art Unit 2137